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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/664,518

09/17/2003

Theodore B. Shockley

35481-73372

4878

23643

7590

07/26/2006

BARNES & THORNBURG
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INDIANAPOLIS, IN 46204

EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,518

Applicant(s)

SHOCKLEY, THEODORE B.

Examiner

Mark T. Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 11, 12, 16, 17, 19, 21 and 23-27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5, 11, 12, 16, 17, 19, 21, 23-27 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED OFFICE ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 11, 12, 16, 21 and 25 have been amended for further examination. Claims 6-10, 13-15, 18, 20, and 22 have been canceled.

Response to Amendment

2. The affidavit under 37 CFR 1.132 filed on July 7, 2006 is insufficient to overcome the rejection of claims 1-5, 11, 12, 16, 17, 19, 21, 23-27 based upon a no evidence of long-felt need as set forth in the last Office action because: the affidavit states that the claimed subject matter solved a problem that was long standing in the art. However, there is no evidence that if a

person skilled in the art, who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. Furthermore, it is noted on page 2, lines 7-12 of the affidavit, applicant appears to admit that it is known to others that thinner stock was/is known to jam dispensing machines, cut the hands of persons handling the tickets, and wear quicker than thicker stock paper. So, although not the preferred paper of choice for tickets, it appears that ordinary skilled artisans in the past have readily contemplated use of the thinner stock and, for that matter, likely produced tickets of the thinner stock only to discover the above. Applicant appears to believe what was readily contemplated in the past by ordinary skilled artisans should be novel today simply because the stock used is simply not preferred, or now manufactured, but never admittedly ruled out. See MPEP 716.04

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 11, 12, 16, 17, 19, and 24 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Submission of Prior Art (ASPA) in view of McCall et al (6,322,667).

ASPA discloses a tube and a plurality of tickets wrapped around the tube, the plurality of tickets having interconnected ends defining rows of perforations therebetween (see Fig. 1 Prior Art).

However, ASPA does not disclose a substrate having a caliper characteristic between 5 and 7.5 points (1 point equals .0001 inches) and an opacity characteristic over 98%.

McCall discloses in Fig. 10, 15 and 17, paper substrate having the caliper characteristic of 188 um (.0073in or 7.3 points as shown in Table 15), and an opacity of 98.1% (Table 17).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify ASPA's ticket with a paper substrate having a caliper of 7.3 and an opacity of 98.1% as taught by McCall for providing an alternative paper substrate.

In regards to **Claims 2 and 16**, wherein the roll comprises 1000 or 2000 tickets, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any required number of tickets on the roll, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. Furthermore, applicant has failed to disclose that these values are critical to the invention.

In regards to **Claims 3 and 17**, wherein the diameter of the roll is less than 4.5 inches or 6.5 inches, it would have been an obvious matter of design choice to provide any required dimension for the diameter of the roll, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Furthermore, applicant has failed to disclose that these values are critical to the invention.

In regards to **Claims 5, 11, and 12**, it would have been obvious to construct the substrate paper in any desirable caliper and opacity size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would have been obvious to construct the paper substrate in any desirable caliper and opacity size, since applicant has not disclosed the criticality of having a particular opacity and caliper dimensions, and invention would function equally as well in any desirable size dimension.

4. Claims 21, 24 and 27 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes (4,270,774) in view of McCall.

Barnes discloses in Fig. 2-4, a strip of stock paper defining a plurality of tickets, wherein the tickets have interconnected ends defining rows of perforations therebetween and being folded along the perforations (see Fig. 4 and Col. 2, lines 2-8) to provide a layer or deck of tickets.

However, Barnes does not disclose a substrate having a caliper characteristic between 5 and 8 points (1 point equals .0001 inches) and an opacity characteristic less than 98%.

McCall discloses in Fig. 10, 15 and 17, paper substrate having the caliper characteristic of 193 um (.00753in or 7.53 points as shown in Table 15), and an opacity of 97.8% (Table 17).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Barnes's tickets with a paper substrate having a caliper of 7.3 and an opacity of less than 98% as taught by McCall for providing an alternative paper substrate.

5. Claims 23 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes (4,270,774) in view of McCall, and further in view of Shoemaker (6,796,487).

Barnes as modified by McCall discloses a plurality of tickets comprising all the elements as claimed in Claim 21, and as set forth above. However, Barnes does not disclose wherein each ticket has a marking (barcode) for triggering a light and sensor ticket counting device.

Shoemaker discloses in Fig. 3 and in Col. 2, lines 40-48 wherein each ticket has a dark line (barcode shown in Fig. 3 and 4).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Barnes's and McCall's tickets with printed indicia as taught by Shoemaker for triggering a light and sensor ticket counting device.

6. Claim 25 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes in view of McCall, and further in view of Greenaway (4,143,810).

Barnes as modified by McCall discloses a plurality of tickets comprising all the elements as claimed in Claim 24, and as set forth above. However, Barnes does not disclose wherein each ticket has no bar-code and has a dark line having a ticket counting indicia for triggering a light ticket counting device.

Greenway discloses in Fig. 5, a ticket having a dark line (Col. 3, lines 33-54) having ticket counting indicia (5).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Barnes's and McCall's tickets with no bar codes and a dark

line having machine readable indicia markings as taught by Greenaway for triggering an optical sensor.

In regards to **Claim 25**, wherein the indicia is used to trigger a light ticket counting device, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the indicia of Greenaway is capable of triggering an optical light ticket counting device.

7. Claim 26 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes (4,270,774) in view of McCall, and further in view of Horniak (5,211,093).

Barnes as modified by McCall discloses a plurality of tickets comprising all the elements as claimed in Claims 21 and 24, and as set forth above. However, Barnes does not disclose wherein each ticket has an aperture or notch for triggering a light and sensor ticket counting device.

Horniak discloses in Fig. 1, 3, 5, and in Col. 2, lines 9-22 and Col. 3, lines 29-45 wherein each ticket has a notch or aperture (34).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Barnes's and McCall's tickets with apertures or notches as taught by Horniak for triggering a light and sensor ticket counting device.

Response to Arguments

Applicant's argument's filed on July 7, 2006 have been fully considered, but they are not persuasive.

In response to applicant's argument that neither the ASPA or the McCall references teach or suggest providing "tickets from a caliper characteristic between 5 and 8 points", the examiner submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). *Webster's Dictionary* defines "ticket" as "a slip, card or label substrate recording a transaction or undertaking or giving instructions." In its broadest sense, it is basically a substrate having indicia for a particular purpose. The ASPA reference is cited for disclosing a plurality of tickets wrapped around a tube, wherein the tickets have interconnected ends defining rows of perforations there between (see Fig. 1 of Prior Art). However, ASPA does not disclose a substrate having a caliper characteristic between 5 and 7.5 points (1 point = .0001 inches) and an opacity characteristic over 98%. It is noted in the applicant's affidavit filed July 7, 2006, on page 2, lines 7-12, applicant appears to admit that it is known to others that thinner stock was/is known to jam dispensing machines, cut the hands of persons handling the tickets, and wear quicker than thicker stock paper. So, although not the preferred paper of choice for tickets, it appears that ordinary skilled artisans in the past have readily contemplated use of the thinner stock and, for that matter, likely produced tickets of the thinner stock only to discover the above.

Applicant appears to believe what was readily contemplated in the past by ordinary skilled artisans should be novel today simply because the stock used is simply not preferred, or now manufactured, but never admittedly ruled out.

In any event, attention is directed to the McCall et al reference, which discloses in Col. 14 (lines 57-65), Col.15 (lines 10-27), Col. 17 (Table 15 for Physical Properties), and Col. 18 (Table 17 for Optical Properties), that for a given type of air-dried paper, the caliper was listed as 188um (.0073 inches or 7.3 points), and 193um (.007527 inches or 7.53 points). In Table 17, for the same type of paper, the opacity was also listed for an air-dried paper to be 98.1% and 97.8%.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify ASPA's ticket with paper material characteristic of a 7.3 point caliper and a 98.1% caliper, and a caliper less than 98% as taught by McCall or, for that matter, any of a large variety of papers for providing an alternative paper substrate material.

In response to applicant's argument that McCall reference is nonanalogous art to be combined with ASPA, the examiner submits that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, McCall et al is merely teaching that a substrate or paper (without the indicia for intended use as a ticket) can be constructed with the opacity and caliper characteristics as disclosed by applicant's invention. Again, the McCall et al reference is not

used for disclosing the intended use as stated by applicant, but is only used for disclosing the physical make up of the paper itself.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

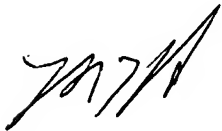
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Greenaway et al, Gluseppe, and Siemiatkowski et al disclose similar indicia on a ticket.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Monica Carter, can be reached at (571) 272-4475. The formal fax number for TC 3700 is (571) 273-8300.



MTH

July 19, 2006


MONICA CARTER
SUPERVISORY PATENT EXAMINER